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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,668	11/25/2003	Otto E. Anderhub	06530.0311	6222
22852	7590	02/05/2009		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER BACHMAN, LINDSEY MICHELLE	
			ART UNIT 3734	PAPER NUMBER
			MAIL DATE 02/05/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/720,668

Applicant(s)

ANDERHUB ET AL.

Examiner

LINDSEY BACHMAN

Art Unit

3734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-27,31-50,52-65 and 87-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-27,31-50,52-65 and 87-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is in response to Applicant's amendment filed 16 October 2008.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 6-27, 31-50, 52-65 and 87-94 are rejected under 35 U.S.C. 103(a) as obvious over Paternuosto (WO 01/30242 A1) in view of Jaeger (US 4,763,669).

Claim 1, 2, 6, 12-15, 17, 20-27, 36-39, 41, 44-49, 56-58, 61-65: Paternuosto discloses a forceps having a first jaw (10a) and a second jaw (10b). The second jaw has a cutting edge (12), a holder (remainder of 10b shown in fig. 7) and a storage portion (22). The storage portion has holes 24. The holder portion has a groove shown in fig. 9 for receiving a lip on the storage portion. The two jaws are pivotally attached to each other. Each of the jaws has a sharpened cutting edge for mating together to cut tissue. The storage portion receives the cut tissue for biopsy.

Since the cutter and holder of Paternuosto are integral, Paternuosto does not teach that the cutting portion has a protrusion for being received on the holder. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cutter and holder separate, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179. Further, Jaeger'669 teaches a forceps having two jaws (34, 36) with a cutting portion (64) removably attached to the

jaw (column 2, lines 33-36). The cutting portion (64) has a protrusion (66) that is received on the holder (at 52) (column 4, line 55 to column 5, line 2) in order to make the blade removable for the purpose of sharpening the blade and then replacing it. It would have been obvious to one of ordinary skill in the art to modify the device of Paternuosto with the removable blade of Jaeger'669 so that it too has this advantage.

Claim 16, 40, 50, 91, 92, 94: Jaeger'669 teaches that the cutting portion has a non-straight portion (Figure 5) connecting a tang (66) to a cutting edge (64). The tang (66) is configured to be received in a correspondingly shaped gap (52) in the holder (shown in Figure 4). This configuration, as discussed above, is provided in order to make the blade removable for the purpose of sharpening the blade and then replacing it (column 2, lines 33-36). It would have been obvious to one of ordinary skill in the art to modify the device of Paternuosto with the removable blade of Jaeger'669 so that it too has this advantage.

Claims 87, 88, 89, 90, 93: Jaeger'669 shows that the tang (66) aids in defining the pivot bore (formed by frame portion with elements 64 and 62) and an actuator hole (formed by frame portion with elements 60, 60, 62, 63, and 64).

Claims 6-11, 13, 14, 18, 19, 31-35, 42-43, 52-55, 59-60: Paternuosto in view of Jaeger discloses or makes obvious the invention as claimed with the exception the materials of the different components.

Regarding the material of the different components, the examiner contends that such is nothing more than a mere obvious design choice. Cutting edges were previously known as being manufactured out of plastic or metal. Forming two removable

components out of different materials would allow for one material to be sharpened and the other material to be less expensive, for example.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LINDSEY BACHMAN whose telephone number is (571)272-6208. The examiner can normally be reached on Monday to Thursday 7:30 am to 5 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/L. B./
Examiner, Art Unit 3734

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3734